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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/763,991

Applicant(s)

MOHAN, KRISHNA

Examiner

John Shin

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 45-49, 58-60 and 70-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44, 50-57, and 61-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-44, 50-57, and 61-69, drawn to a method of data gathering, classified in class 705, subclass 16.
 - II. Claims 45-49 and 58-60, drawn to a method of returning a purchased item, classified in class 705, subclass 20.
 - III. Claims 70-77, drawn to an apparatus for attaching and detaching a portable memory device, classified in class 710, subclass 74.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as being used in a business transaction involved in returning a purchased item. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of invention III can be used to practice a process that uses the apparatus to transmit customer authentication information during a business transaction, as opposed to gathering data.

4. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of invention III can be used to practice a process that uses the apparatus to transmit customer authentication information during a business transaction, as opposed to processing a return.

5. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Krishna Mohan on March 18, 2008 a provisional election was made without traverse to prosecute the invention of group I, claims 1-44, 50-57, and 61-69. Affirmation of this election must be made by applicant in replying to this Office action. Claims 45-49, 58-60, and 70-77 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

7. Claim 11 objected to because of the following informalities: on the last two lines, the claim recites "said customer to to detach". The second "to" is redundant.

Appropriate correction is required.

8. Claim 25 is objected to because of the following informalities: the claim recites the term "extensible manipulation language" as a reference to XML, according to the specification. The examiner notes that the proper unabbreviated term for XML is "extensible markup language". Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 7 recites the limitations "the device configuration file" and "the unique customer identification data" in lines 2 and 4 of the claim. There is insufficient antecedent basis for these limitations in the claim. The examiner believes that the applicant intended to make claim 7 depend on claim 6 and is interpreting it as such for examination purposes.

12. Claims 8-10 depend on claim 7 and thus inherit the defects of their parent claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 3, 4, 15-21, 26, 29-31, 33, 50, 54, 55, and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (2003/0126020).
15. Regarding claim 1, Smith shows a method of data gathering using a portable memory device, the method comprising:

- a customer conducting at least one business transaction with at least one vendor at a point of sale (paragraphs 17, 18);
- connecting said portable memory device to a first computer system used by said vendor, during said business transaction, wherein said portable memory device is received from said customer at said point of sale (paragraphs 17, 18);
- receiving a set of data from a data processing system used by said vendor, wherein said set of data is generated as the result of said customer conducting said business transaction (paragraphs 17, 18);

- preparing data contents of at least one of following data file:
 - a transaction data file and an electronic receipt file, using said set of data and creating at least one of said transaction data file and said electronic receipt file in said portable memory device (paragraphs 17, 18); and
 - detaching said portable memory device from said first computer system and said customer receiving back said portable memory device (paragraphs 20, 35: *In cases when an electronic receipt is transferred from the vendor to the WPD via a wired connection, it naturally follows that the WPD must be disconnected afterwards and given back to the consumer because the WPD belongs to the consumer; see paragraph 18*).

16. Regarding claim 3, Smith shows connecting a portable memory device to a second computer system; and identifying at least one of said transaction data file and said electronic receipt file in said portable memory device and extracting each of the identified file into a second database (paragraph 34: *in order to transfer data to the secondary computing device 30, the WPD must be connected to the secondary computing device*).

17. Regarding claim 4, Smith shows performing the method of claim 3 by a customer over a period of time, after collecting a plurality of the data files in said portable memory device, corresponding to a plurality of said business transaction from a plurality of said vendor (paragraph 38: *combining receipt information to obtain a running total shows collecting a plurality of data files over time*).

18. Regarding claims 15-18, Smith shows the limitation wherein said identifying and extracting step is used in a management and accounting software product (paragraph 3). Smith does not expressly show the limitations wherein said identifying and extracting step is used in a personal finance management software product, document management software product, business finance management software product, or enterprise content management software product; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

19. Regarding claims 19-21, Smith shows the limitations wherein

- said customer is one of an individual, a business entity, a household entity and a government entity (paragraph 17);
- said vendor is one of a business entity and a government entity (paragraph 17);
and
- said vendor is one of a seller of products and a seller of services (paragraph 17).

20. Regarding claim 26, Smith shows the limitation wherein said data processing system is a data processing system that processes said business transaction at said point of sale (paragraph 17).

21. Regarding claims 29 and 30, Smith does not expressly show the limitations wherein said portable memory device is a compact flash memory product or a compact memory card. However, the examiner notes that these differences are simply a matter of design choice in light of the method already disclosed by Smith. Such modification would not have otherwise affected the method of Smith and would have merely represented one of numerous steps that a skilled artisan would have found obvious for the purposes already disclosed by Smith. Additionally, applicant has not persuasively demonstrated the criticality of providing this step versus the steps disclosed by Smith. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

22. Regarding claim 31, Smith shows the limitation wherein said portable memory device is a unitary portable memory device having a universal serial bus connector adapted to the storage device, the device capable of being directly connected to a computer via the connector (paragraph 31).

23. Regarding claim 33, Smiths shows the limitations of this claim. Please see the comments regarding claim 1 above.

24. Regarding claim 50, Smith shows a computer readable medium storing a computer program with a plurality of code sections, when executed by a computer, causes the computer to perform the steps of:

- receiving a set of data from a data processing system, wherein said set of data is generated as the result of a customer conducting a business transaction with a vendor at a point of sale (paragraph 37);

- preparing data contents of at least one of a transaction data file and electronic receipt file using said set of data (paragraphs 17, 18); and
- creating at least one of said transaction data file and said electronic receipt file in a portable memory device, wherein said portable memory device is provided by said customer during said business transaction at said point of sale (paragraphs 17, 18).

25. Regarding claims 54 and 55, Smith does not expressly show the limitations wherein said transaction data file is in a personal or business finance management software program readable format; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

26. Regarding claim 61, Smith shows a computer readable medium storing a computer program with a plurality of code sections, when executed by a computer, causes the computer to perform the steps of:

- identifying at least one of the following data file: a transaction data file and an electronic receipt file, in a portable memory device attached to said computer,

wherein the data files are received by a customer from one or more vendors at a point of sale (paragraph 38); and

- extracting each of the data file into a database (paragraph 38).

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. Claims 6, 7, 12-14, 27, 28, 34-36, 38-42, 51, 57 and 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.

29. Regarding claim 6, Smith shows a device configuration file in said portable memory device, wherein said device configuration file comprising at least one of a: unique customer identification data; unique user identification data; an indication of whether said customer would like to receive said electronic receipt file into said portable memory device; an indication of how to represent payment card identification in said transaction data file and said electronic receipt file; and one or more user defined data (paragraph 32). Although Smith does not expressly show a customer creating this device configuration file, the examiner notes that in order for a biometric scanner to properly identify a user, the user must first calibrate the device with his or her biometric

data. Such an act of calibration can be considered a step in which the user creates a device configuration file comprising unique user identification data.

30. Regarding claim 7, Smith does not expressly show the limitation wherein said preparing step further comprises checking for existence of the device configuration file in said portable memory device. However, Smith shows that when the user first accesses the portable memory device in order to receive an electronic receipt from the vendor, the user may identify him or herself by inputting biometric information (paragraph 32). Because this identification information is stored in the device configuration file, as discussed in the comments regarding claim 6 above, it would necessarily follow that the portable memory device would have to check for the existence of such a file when authenticating the user. Therefore, Smith shows this limitation.

Regarding the limitations pertaining to extracting the unique customer identification data from the device configuration file and associating the unique customer identification data with one or more data elements of said set of data and storing in a first database, the examiner notes that this is a further limitation of an element (namely, "the unique customer identification data") that is part of a logical disjunction of elements in the parent claim. For examination purposes, the examiner has chosen the element "unique user identification data". Therefore, these limitations involving "the unique customer identification data" are not being considered.

31. Regarding claim 12, Smith shows the limitation wherein a customer is provided with a portable memory device and the portable memory device is identified by creating

a unique user identification in the device configuration file in said portable memory device, whereby said customer can gather data from a plurality of business transactions (see comments regarding claim 6 above). However, Smith does not expressly show the limitation wherein said customer is represented by a plurality of users, wherein, some or all of the users are provided with said portable memory device and each of said portable memory device is identified by creating unique user identification in the device configuration file in said portable memory device, whereby said customer can gather data from a plurality of said business transaction in a multi-user environment. However, the act of simply incorporating the portable memory device of Smith into a multi-user environment is an obvious variant of the system and method disclosed by Smith, and it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of gathering data of Smith by incorporating it into a multi-user environment in order to accommodate a wider range of users.

32. Regarding claim 13 and 14, Smith does not expressly show the limitations wherein the method of claim 12 is used by a customer for processing employee travel expenses, wherein said user is an employee of said customer; or used by said customer for consolidating household expenses, wherein said user represent a household member; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

33. Regarding claims 27 and 57, Smith does not expressly show the limitation wherein said preparing and creating step is used in a software product used for processing said business transaction. However, Smith does reveal that the vendor device generates the electronic receipt at the time of transaction, which necessitates the use of a software product. Also, it would be highly plausible for this software product to be integrated with the software product used to process business transactions in order to access receipt data. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by causing the preparing and creating step to be used in a software product used for processing business transactions in order to make it easier for the software system to extract receipt data.

34. Regarding claim 28, Smith shows that the exchange of information between the vendor device and the purchase device includes identification and authorization information regarding the purchaser (paragraph 36). When this step of identification and authorization occurs is simply a matter of design choice and does not distinguish the claimed invention from the prior art in terms of patentability. Regarding the limitations concerning disconnecting said portable device and notifying at least one of said customer and said vendor to detach said portable memory device, please see the comments regarding claim 2 below.

35. Regarding claim 34, Smith shows all the limitations of the claim (see comments regarding claim 1 above) but does not expressly show the limitations wherein the apparatus is attached and detached without human assistance from said vendor or the limitation wherein the portable memory connector is attached to a location easily accessible and visible by said customer at said point of sale. However, the concept of self-service point-of-sale terminals is old and well-known in the art, and because Smith discloses a portable memory device that can connect to the vendor device via USB connection, the act of the customer attaching and detaching such a portable memory device independent of any vendor assistance would be an obvious variant of the invention disclosed by Smith. Also, in order for the customer to attach and detach such a portable memory device without assistance, the connection ports would necessarily have to be in a location easily accessible and visible by said customer at said point-of-sale. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of gathering data of Smith by adding the above limitations in order to increase customer convenience at point-of-sale terminals.

36. Regarding claims 35 and 36, Smith shows the limitation wherein said portable memory connector comprising a universal serial bus socket, placed within a socket case, wherein said universal bus socket is capable of accepting a unitary portable memory device with a universal serial bus connector and the limitation wherein said first connecting means is combination of a data cable and a data port connector, capable of connecting said portable memory connector to a universal serial bus port of said first computer system (paragraph 31).

37. Regarding claim 38, the concept of self-service terminals is old and well-known in the art. Please see the comments regarding claim 34 above.

38. Regarding claims 39 and 40, Smith does not expressly show the limitations wherein the self-service terminal is an automatic checkout counter or an automatic teller machine; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

39. Regarding claim 41, Smith shows the limitation wherein said self-service terminal is a vending machine (paragraph 33).

40. Regarding claim 42, Smith shows a data gathering method comprising:

- said customer entering into a business transaction with said vendor at a point of sale (paragraphs 17, 18);
- connecting said portable memory device to a computer system used by said vendor at said point of sale (paragraphs 17, 18);
- reading said identification data of said customer from said device configuration file (paragraph 36);

- receiving a set of data from a data processing system, wherein said set of data is generated as the result of said customer conducting said business transaction with said vendor (paragraph 37); and
- associating one or more of a data element from said set of data with said identification data and storing in a database (paragraphs 37, 38: *The fact that the information exchange includes the purchaser ID along with other purchase transaction data shows associating; the secondary computing device 30 in paragraph 38 is the database*).

Smith does not expressly show the limitation wherein a customer creates identification data in a device configuration file in a portable memory device, wherein said identification data uniquely identifies said customer to a vendor, but this limitation must be present in the invention of Smith based on the disclosed limitations (paragraph 32; see comments regarding claim 6 above).

41. Regarding claim 51, please see the comments regarding claim 7 above pertaining to checking for a device configuration file in said portable memory device. Smith shows extracting a customer identification data from said device configuration file (paragraph 37: *when the customer's WPD connects to the vendor's WVD, the purchaser's identity data is transmitted*) and associating one or more of a data element from said set of data with said customer identification data and storing in a database (paragraph 38: *the creation of electronic receipts shows associating customer ID data with one or more elements from said set of data, and the act of archiving these receipts in a secondary computing device shows storing in a database*).

42. Regarding claim 63, Smith shows creating a device configuration file in said portable memory device with at least one of: first data parameter assigned with unique customer identification data value; second data parameter assigned with unique user identification data value; third parameter assigned with the customer choice indicating whether the customer would like to receive the electronic receipt file in said portable memory device; fourth parameter assigned with the customer choice indicating whether the customer would like to receive a business promotion file in said portable memory device; and fifth data parameter assigned with a data value selected from a plurality of values, indicating how the vendor should identify a payment card used for the business transaction in the transaction and electronic receipt files (*See comments regarding claim 6 above. When the device configuration file is created to store the user's biometric identification information, the act of storing this data is in effect storing a parameter assigned with a unique user identification data value*).

43. Regarding claims 64-67, Smith does not expressly show the limitations wherein said identifying and extracting step is used in a personal finance, business finance, document, or enterprise content management software product to automatically extract the data files into said database, wherein said database is a database used by said personal finance, business finance, document, or enterprise content management software product. However, Smith does show extracting electronic receipt information into management and accounting software (paragraph 3), and it is old and well-known in the art for such processes to be automated. Also, Smith shows that such data extraction can occur between the portable memory device and a secondary computing

device, such as a desktop computer (paragraph 34). In cases where the management software product is installed on such a desktop computer, the database into which the data files are extracted is the same as that which used by the management software. As for the limitations regarding the nature of the management software product being related to personal finance, business finance, document, or enterprise content management, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP*, 2106.

44. Claims 2, 5, 11, 25, 32, 37, 44, 52, 56, 62, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of official notice.

45. Regarding claim 2, Smith does not expressly show the limitations wherein said detaching step further comprises disconnecting said portable memory device from an operating system executing in said first computer system; and notifying at least one of said customer and said vendor to detach said portable memory device from said first computer system. However, the examiner takes official notice that it is notoriously old

and well-known in the art to disconnect portable memory devices from operating systems and to afterwards notify the user that the device may be disconnected. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data collecting method of Smith by adding the ability to disconnect a portable memory device from an operating system and to notify either the customer or vendor to detach said portable memory device in order to prevent data loss and/or data corruption in the portable memory device.

46. Regarding claims 5 and 62, Smith does not expressly show the limitation wherein said identifying step is by means of a computer-implemented search of the file system of said portable memory device by using at least one of a pre-determined file name pattern and pre-determined file data content pattern. However, the examiner takes official notice that it is notoriously old and well-known in the art to search the file system of any electronic device by using a pre-determined file name pattern or a pre-determined file data content pattern. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of collecting data of Smith by adding the ability to execute the identifying step by means of a computer-implemented search of the file system of said portable memory device by using at least one of a pre-determined file name pattern and pre-determined file data content pattern in order to provide a method that quickly and accurately locates desired data within a file system.

47. Regarding claim 11, Smith does not expressly show:

- providing a third computer program in said portable memory device, wherein

- said third computer program automatically starts executing during the said connecting to the second computer system step and
- when executing, instructs a second computer program executing in said second computer system to automatically identify and extract one or more of the data files into said second database; and
- disconnecting said portable memory device and instructing said customer to detach said portable memory device from said second computer system.

However, the examiner takes official notice that it is notoriously old and well-known in the art for portable memory devices to run automatic data archive and retrieval programs when connected to another storage device. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by adding the step of invoking a third computer program as described above in order to increase user convenience when transferring data from the portable memory device to another storage device. As for the limitation concerning disconnecting said portable memory device, please see the comments regarding claim 2 above.

48. Regarding claims 25 and 52, Smith does not expressly show the limitation wherein said transaction data file is in an extensible manipulation language format. However, the examiner takes official notice that it is notoriously old and well-known in the art to store data files in XML format. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method

of Smith by adding the ability to store transaction data files in XML format in order to make the data more accessible to a wider variety of computing devices.

49. Regarding claim 32, Smith does not expressly show the limitation wherein said portable memory device is a unitary portable memory device having a firewire data port connector adapted to the storage device, the device capable of being directly connected to a computer via the connector. However, the examiner takes official notice that it is notoriously old and well-known in the art to connect a portable memory device to another device using a firewire data port. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by adding the ability for the portable memory device to connect to a storage device using a firewire data port in order to provide the user with a fast and convenient means for transferring data.

50. Regarding claim 37, Smith does not expressly show the limitation wherein said portable memory connector comprises a memory card reader. However, the examiner takes official notice that it is notoriously old and well-known in the art portable memory devices to communicate with other devices via a memory card reader. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by adding the ability for the portable memory connector to comprise a memory card reader in order to increase flexibility when transferring data.

51. Regarding claim 44, Smith does not expressly show the limitation wherein said creating the identification data is by means of said customer connecting to a remote

website on the Internet and requesting and receiving said identification data. However, the examiner takes official notice that it is notoriously old and well-known in the art to obtain a unique ID through a website. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by adding the ability to create identification data by connecting to a remote website in order to provide the user with a convenient means for obtaining a secure ID.

52. Regarding claims 56 and 69, Smith shows a portable memory device capable of presenting a plurality of messages to and receiving a plurality of inputs from at least one of a customer and vendor (Fig. 1), but does not expressly show creating multiple user interaction sessions at different time intervals during various stages of execution of said computer program for presenting a plurality of messages to at least one of said customer and said vendor and receiving a plurality of inputs from at least one of said customer and said vendor. However, the examiner takes official notice that it is notoriously old and well-known in the art to create multiple interaction sessions during various stages in a program's execution. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the computer readable medium of Smith by adding the ability to create multiple user interaction sessions in order to provide a program execution context that is both modular and dynamic.

53. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Matsumori (2004/0181456).

54. Regarding claims 8-10, although Smith does not expressly show the following limitations, they are shown by Matsumori:

- vendor using a database to identify frequent customers (paragraph 29);
- vendor checking for whether said customer qualifies for any business promotion, using the data from said first database and if qualifies, providing the business promotion to said customer (paragraph 45); and
- providing the business promotion step is by means of creating a business promotion file in said portable memory device, wherein said business promotion file comprising at least one of: a textual description of the business promotion provided by said vendor; and a uniform resource locator hyperlink, when clicked by said customer, directs said customer to a website in the Internet to participate in said business promotion (paragraph 45).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of gathering data of Smith by adding the above limitations taught by Matsumori in order to increase repeat sales for the vendors.

55. Claims 22-24 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Darrell (2005/0010505).

56. Regarding claims 22, 23, and 53, Smith does not expressly show the limitation wherein said electronic receipt file is a computer image representation of corresponding paper receipt of said business transaction wherein said transaction data file comprises all of the information that can be found in a corresponding paper receipt of said business transaction. However, Darrell shows these limitations (paragraph 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of gathering data of Smith by adding the ability to generate computer image representations of corresponding paper receipts as taught by Darrell in order to provide a convenient way for customers to accumulate receipt data.

57. Regarding claim 24, Darrell also shows the limitation wherein said transaction data file further comprising at least one of: a category of said vendor; a category of said business transaction; and a subcategory for each individual line items of said business transaction (paragraph 5).

58. Claims 43 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al in view of Hiramoto (2003/0184797).

59. Regarding claims 43 and 68, Smith does not expressly show the limitation wherein said creating the identification data is done by providing a computer program to said customer, wherein each installation of said computer program has a plurality of customer identification data values that are unique to each of the installation of said computer program, and said customer choosing one customer identification data value

from said plurality of customer identification data values and creating said identification data by using the chosen customer identification data value. However, Hiramoto shows this limitation (paragraphs 5, 6). It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the data gathering method of Smith by adding the above limitations taught by Hiramoto in order to make the identification process more secure.

Conclusion

60. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shiftan et al (2004/0220964) – Shows a method and apparatus for managing electronic receipts on portable devices

Marshall et al (2003/0055733) – Shows method for transmitting electronic receipts from a terminal to a mobile device

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Shin whose telephone number is (571) 270-3276. The examiner can normally be reached on Monday to Friday, 10:30 am - 7:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Gart can be reached on (571) 272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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March 25, 2008

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